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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of) Group Art Unit: 2854
Michael HELD et al.) Examiner: Ren Luo Yan
Application No. 10/555,091)
Filed November 2, 2005)
For: ROTARY FOLDER COMPRISING A)
CUTTING DEVICE FOR CROSS-)
CUTTING AT LEAST ONE WEB)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement, which was mailed to the undersigned in the subject U.S. patent application on June 13, 2008, applicants elect to prosecute, in this patent application, the invention or group of inventions identified by the Examiner as Group IV, claims 28 and 34, which are drawn to a wheel folding apparatus. This election is made with traverse. Applicants expressly reserve the right to file one or more divisional applications directed to the inventions or groups of inventions not selected for prosecution in the subject U.S. patent application.

37 CFR 1.499 recites that if the Examiner finds that the national phase application lacks unity of invention, under 37 CFR 1.475, the Examiner may require the applicant to elect the invention to which the claims will be restricted. Referring to 37 CFR 1.475, it is recited that the national stage application shall relate to one invention or to one group of inventions so linked as to form a single inventive concept. The Examiner has asserted that under PCT Rule 13.2, the claims in the subject application lack the same or corresponding technical feature because, in

the opinion of the Examiner, independent claim 28 does not patentably define over the teachings of U.S. patent No. 3,762,697 in view of U.S. patent No. 5,692,440.

In the International Search Report, there was no issue of lack of unity. All of claims 1-27, which correspond to claims 28-54, as pending in the subject application, were held to have both novelty and inventive activity. The prior art cited in the International Search Report includes DE 19 17 235 which is the German equivalent to U.S. patent No. 3,762,697, the primary reference cited and relied on by the Examiner in support of his assertion of lack of a single general inventive concept. MPEP Section 1850 recites, in part, that "Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach." In the present situation, where the primary reference relied on by the Examiner in the subject application did not give rise to a holding of lack of unity in the International Search Report in the corresponding PCT application, it is believed that the lack of unity position taken by the Examiner in the subject application is being applied in a narrow, literal or academic approach. The assertion by the Examiner, that the sole independent claim is not patentable over a combination of two references, one of which was already applied by the International Searching Authority, precludes the applicants their opportunity to obtain a scope of claim protection which is commensurate with their invention. Accordingly, withdrawal of the Restriction Requirement, and an Office Action on the merits of all of the claims, is respectfully requested.

Respectfully submitted,

Michael HELD et al.
Applicant

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